

## REMARKS

This Response is submitted in reply to the non-final Office Action dated February 14, 2008. Claims 1 to 49 and 81 to 94 are pending in this application. Claims 1, 9, 13, 21, 25, and 81, 82, 91, and 93 have been amended. No new matter is introduced by these amendments. Non-elected Claims 50 to 80 have been cancelled without prejudice or disclaimer. Claims 6, 18, 19, 83, and 88 have also been canceled. Claims 95 and 96 are newly added.

A Terminal Disclaimer and a Petition for a one-month extension of time are submitted herewith. Please charge deposit account number 02-1818 to cover the cost of the Terminal Disclaimer, the extension of time, and any other fees which are due in connection with this Response.

The Office Action rejected Claims 1 to 49 and 81 to 94 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over Claims 1 to 50 of co-pending patent application no. 09/934,003. Applicant is submitting a Terminal Disclaimer in compliance with 37 C.F.R. 1.321(c) to overcome this rejection.

The Office Action rejected Claims 1 to 7, 9 to 19, 21 to 49, 81 to 89 and 91 to 94 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,589,114 to Rose ("Rose"). Applicant respectfully disagrees with these rejections. Nevertheless, certain of the claims have been amended for clarification purposes.

Rose discloses a shuffle feature in which value-based symbols generated along an active pay line each reveal a respective number superimposed over each of the symbols (Col. 3, line 64 to Col. 4, line 4). The revealed numbers represent each of the respective digits of a credit amount that defines a first award which is not awarded to the player (Col. 4, lines 6 to 11). When executing the shuffle feature, the CPU in Rose randomly selects one of a possible number of credit amounts which include different arrangements of the revealed numbers based on a weighted probability table (Col. 4, lines 31 to 33). The CPU then causes the symbols and their respective numbers to be re-ordered to show the randomly-selected credit amount that defines a second award which is awarded to the player (Col. 4, lines 47 to 50 and lines 21 to 25). The revealed numbers remain with the respective symbols as the symbols are re-ordered such that the numbers are likewise re-ordered (Col. 4, lines 15 to 18 and Figures 5 to 7). This

random re-ordering may occur with or without "player interaction" to define an award given to the player (Col. 5, lines 3 to 9).

Amended independent Claim 1 is generally directed to a gaming device which includes, amongst other elements, a processor programmed to operate with a display device to: (a) display a plurality of player-selectable digit positions, (b) select and display one of the digits, (c) enable a player to select one of the digit positions for the selected digit, (d) associate and display the selected digit with the digit position selected by the player, (e) repeat (b) to (e) at least once, and (f) determine and display an award based on an order of the digits associated with the digit positions selected by the player.

Unlike the gaming device of amended independent Claim 1, Rose does not disclose a processor programmed to operate with a display device to: (a) display a plurality of player-selectable digit positions, (b) select and display one of the digits, (c) enable a player to select one of the digit positions for the selected digit, (d) associate and display the selected digit with the digit position selected by the player, (e) repeat (b) to (e) at least once, and (f) determine and display an award based on an order of the digits associated with the digit positions selected by the player.

In Rose, the numbers representing the digits of the first award (i.e., the award prior to the re-ordering) are all revealed to the player at the same time. The revealed numbers are then randomly re-ordered by the CPU to define a second award, which is provided to a player. Enabling the player to select positions for these revealed numbers would not result in a random re-ordering, and it would be meaningless because the player would always arrange the revealed digits in an order that causes them to have the highest possible value.

Although Rose states that "[t]he scene would include a sequence of value-based symbols that are randomly re-ordered, with or without player interaction, to define an award given to the player," the "player interaction" appears to be associated with randomly re-ordering symbols and has nothing to do with enabling a player to select positions. The "player interaction" contemplated by Rose enables the player to initiate the random re-ordering of the numbers by the CPU after all of the numbers defining the first award have been revealed to the player. For example, as illustrated in Fig. 4 of

Rose, the player may be enabled to initiate a random shuffling of the revealed numbers, zero 60, two 62, and four 64.

Moreover, Rose discloses determining the award to provide to the player by randomly selecting one of a number of possible award amounts based on a probability table that is weighted to favor the smaller award amounts over the higher award amounts, that is weighted equally, or is weighted to favor the higher award amounts over the lower award amounts (Col. 4, lines 50 to 57). Rose fails to disclose determining and displaying an award based on an order of the digits associated with the digit positions selected by the player.

The gaming device of amended independent Claim 1, on the other hand, includes (a) displaying a plurality of player-selectable digit positions, (b) selecting and displaying one of the digits, (c) enabling a player to select one of the digit positions for the selected digit, (d) associating and displaying the selected digit with the digit position selected by the player, (e) repeating (b) to (d) at least once, and (f) determining and displaying an award based on an order of the digits associated with the digit positions selected by the player.

Accordingly, for at least the reasons discussed above, amended independent Claim 1 and the claims depending therefrom are each patentably distinguished over Rose and in condition for allowance.

Independent Claims 13, 25, and 81 each include certain similar elements to amended independent Claim 1. For reasons similar to those discussed above with respect to amended independent Claim 1, independent Claims 13, 25, and 81 and the claims depending from independent Claims 13, 25, and 81 are each patentably distinguished over Rose and in condition for allowance.

Independent Claim 31 is generally directed to a gaming device which includes, amongst other elements: (a) a moveable mechanical display device supported by the cabinet and having a plurality of different modification methods displayed thereon, wherein the mechanical display device is operable to simultaneously display a plurality of the modification methods to a player, (b) an indicator supported by the cabinet and operable to move to indicate one of the modification methods which is displayed when

the mechanical display device stops moving, (c) a display device configured to display an original award including a plurality of digits associated with a plurality of digit positions, wherein the order of the digits displays a value of the original award, and (d) a modified award including a modification of the digits of the original award based on the modification method indicated by the indicator and mechanical display device.

The Office Action admits that Rose does not disclose a moveable mechanical display device. The Office Action concludes, however, that it is notoriously well-known in the art to adapt video display means over movable mechanical means, thus making the gaming machine more efficient and less inclined to any mechanical problems.

Regardless of whether it would have been obvious to modify Rose to include a mechanical display device, the resulting gaming device would not include: (a) a moveable mechanical display device supported by the cabinet and having a plurality of different modification methods displayed thereon, wherein the mechanical display device is operable to simultaneously display a plurality of the modification methods to a player, and (b) an indicator supported by the cabinet and operable to move to indicate one of the modification methods which is displayed when the mechanical display device stops moving.

As discussed above, when executing the shuffle feature (i.e., the re-ordering of the revealed numbers), the CPU in Rose randomly selects one of a possible number of credit amounts which include different arrangements of the revealed numbers based on a weighted probability table. The CPU subsequently causes the symbols and their respective numbers to be re-ordered to show the randomly-selected credit amount. This is the only method for modifying the award in Rose. Thus, Rose does not disclose a plurality of different modification methods.

Rose also does not disclose an indicator operable to move to indicate one of the modification methods. Since there is only one possible award modification method in Rose, it would be pointless to include an indicator to indicate one of the modification methods, so that the player knows which modification method will be applied to the original award. Even if Rose did include such an indicator, it would always indicate the same award modification method because Rose only discloses one such method.

Accordingly, for at least the reasons discussed above, independent Claim 31 and the claims depending from independent Claim 31 are each patentably distinguished over Rose and in condition for allowance.

The Office Action rejected Claims 8, 20, and 90 under 35 U.S.C. §103(a) as being unpatentable over Rose in view of U.S. Patent No. 5,205,555 to Hamano ("Hamano").


The Office Action states that Hamano discloses a gaming device which determines an award for a player by performing a mathematical computation of the numbers that stop on the top line of the reels of the gaming machine. The Office Action asserts that it would have been obvious to one of ordinary skill in the art at the time of invention to incorporate Hamano's process for determining and calculating a player's award into the gaming machine of Rose to provide an electronic game that is more complicated and interesting than relying on an award paid in response to a predetermined of player determined combination that is in a one to one, fixed relationship with a predetermined stored paytable in the gaming machine.

Claims 8, 20, and 90 depend from amended independent Claims 1, 13, and 81, respectively. Regardless of whether it would have been obvious to modify Rose in the manner proposed by the Office Action, Hamano does not cure the deficiencies of Rose described above with respect to amended independent Claims 1, 13, and 81. Accordingly, for at least the reasons discussed above, Claims 8, 20, and 90 are each patentably distinguished over Rose and Hamano and in condition for allowance.

An earnest endeavor has been made to place this application in condition for formal allowance and in the absence of more pertinent art such action is courteously solicited. If the Examiner has any questions regarding this Response, Applicants respectfully requests that the Examiner contact the undersigned.

Respectfully submitted,

BELL, BOYD & LLOYD LLP

BY 

Adam H. Masia

Reg. No. 35,602

Customer No. 29159

Dated: May 29, 2008